Prior to this Reply, Claims 1-43 were pending. Through this Reply, Claims 1, 4, 15 and 27 have been amended, while Claim 44 has been added. In addition, Claim 33 has been cancelled without prejudice to, or disclaimer of, the subject matter contained therein. Accordingly, Claims 1-32 and 34-44 are now at issue in the present case.

I.   Rejections Under 35 U.S.C. § 112

The Examiner rejected Claims 4 and 27 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Specifically, the Examiner found that both the term "said destination" in Claim 4, line 2 and the term "said controller memory" in Claim 27, line 6 lacked antecedent basis.

In response, Applicant has amended Claims 4 and 27. Accordingly, Applicant believes that the rejections of Claims 4 and 27 under 35 U.S.C. § 112, second paragraph, have been overcome.

II.   Rejections Under 35 U.S.C. § 102(e)

The Examiner rejected Claims 1-4, 6, 9-29 and 33-43 under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 6,370,631 to Dye (hereinafter "Dye"). Applicant respectfully traverses the rejection for the reasons provided below.

A.   Claims 1, 15 and 27

1.   Claims 1, 15 and 27 are patentable at least because Dye fails to disclose storing the compressed data in *volatile* memory different from the main memory

Claims 1, 15 and 27 (as amended) require the memory where the compressed data is stored to be *one of SDRAM, DRAM, SRAM or RAM.* Support can be found at least at page 8, lines 16-21 of the present application.

The Examiner asserts that the claimed step of "storing said data in said controller memory" is taught by Dye at Col. 23, lines 6-10. The cited portion of Dye reads as follows:

> the memory controller transferring said compressed replacement
> block to *the non-volatile* memory for storage after said
> compressing said replacement block of data; (emphasis added)

It appears that Dye discloses that when the IMC 140 compresses data, and stores it, the compressed data is stored only on a disk (or other non-volatile memory) or system memory.

The Examiner asserts (with respect to Claim 33) that "Dye teaches said memory comprises a DRAM *[col 14, lines 1-5]*." However, the cited portion of Dye merely notes that the memory control units are used for DRAM refresh operations. There does not appear to be any disclosure of transferring data compressed by the controller to DRAM, as claimed.

In contrast, Claims 1, 15, and 27, as amended, emphasize that the memory where the compressed data is stored is "one of SDRAM, DRAM, SRAM or RAM", all of which are volatile memory, and "different from system memory."

Accordingly, it is believed that Claims 1, 15 and 27, as amended, are patentably distinguishable from Dye, at least, because Dye fails to anticipate a method that includes storing the compressed data in a controller memory which is one of SDRAM, DRAM, SRAM or RAM, and which is *different from* the system memory. For at least the above reasons, Applicant submits that the claims that depend from Claims 1, 15 and 27 are likewise patentably distinguishable from Dye.

> 2.   Claim 15 is further patentable at least because Dye
>   fails to disclose storing the compressed data in
>   volatile memory which is *part of a disk drive controller*

Although Dye discloses that a computer system may have a memory controller (e.g., Fig 1), there is no disclosure that the memory where the compressed data is stored is part of the

controller memory (or disk drive controller). On the contrary, Dye appears to disclose that the Disk 120 (or other non-volatile memory) is separate from the IMC 140 (see, e.g., Fig. 2).

In contrast, Claim 15, as amended, includes the step of writing compressed data to a volatile controller memory, where the disk drive controller *includes* the controller memory. This is illustrated, e.g. in Fig. 2 of the present application.

Accordingly, it is believed that Claim 15, as amended, is patentably distinguishable from Dye, at least, because Dye fails to disclose a method that includes storing the compressed data in a controller volatile memory, which is *included in* the disk drive controller.

B.   Claim 40

Claim 40 is patentable at least because Dye fails to disclose "after said step of compressing at least a first portion of said second data, writing at least a portion of said second data to said memory without compressing said at least a second portion of said second data."

The rejection did not point to any particular portion of Dye that discloses the above-quoted limitations of Claim 40. It appears, however, that the system of Dye would not operate as claimed in Claim 40. If the Examiner persists in a belief that Dye discloses "after said step of compressing at least a first portion of said second data, writing at least a portion of said second data to said memory *without compressing* said at least a second portion of said second data" (emphasis added), then the Examiner is respectfully requested to point to particular language in Dye which discloses the above-quoted limitation.

For at least the above reasons, Applicant submits that Claim 40 is patentably distinguishable from Dye. For at least the same reasons, Applicant believes that the Claims that depend from Claim 40 are likewise patentably distinguishable from Dye.

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Although the comments above are believed to substantively distinguish the cited reference, Applicant does not necessarily accede to the assertions and statements in the Office Action, whether or not expressly addressed.

III.   Additional Claim Fees

In determining whether additional claim fees are due, reference is made to the Fee Calculation Table (below).

Fee Calculation Table

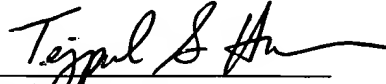|	Claims Remaining After Amendment		Highest Number Previously Paid For	Present Extra	Rate	Additional Fee
Total (37 CFR 1.16(c))	43	Minus	43	= 0	x $18 =	$ 0.00
Independent (37 CFR 1.16(b))	4	Minus	4	= 0	x $86 =	$ 0.00

As set forth in the Fee Calculation Table (above), Applicant previously paid claim fees for forty-three (43) total claims and for four (4) independent claims. Therefore, Applicant believes that no additional claims fees are due. Nevertheless, the Commissioner is hereby authorized to charge Deposit Account No. 50-2198 for any fee deficiencies associated with filing this paper.

IV.   Conclusion

Applicant believes that the application appears to be in form for allowance. Accordingly, reconsideration and allowance thereof is respectfully requested.

The Examiner is invited to contact the undersigned at the below-listed telephone number regarding any matters relating to the present application.

Respectfully submitted,

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Date: Sept. 10, 2004

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